

Applicant : Herbert Howell Waddell
U.S. Serial No. : 09/693,239
Filing Date : October 20, 2000
Page : 2

authorization is hereby given to charge the amount of any such fee to Deposit Account No. 50-1891.

Rejection of Claims under 35 U.S.C. § 103(a)

Claims 1-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Davis (318,359) in view of Decker (4,793,645). The basis for all obviousness rejections is set forth under 35 U.S.C. § 103(a) that provides:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Applicant respectfully traverses and submits that this rejection is in error, as explained more fully below in the responses to the statements made by the Examiner to support the rejection.

RESPONSE TO EXAMINER'S STATEMENTS

A. Immediately after stating the rejection, the Examiner referred to Jones. Jones, 6,120,073, was filed on November 12, 1998, and issued on September 19, 2000. It was not published until it was issued, so was not known to the public when the Applicant filed his provisional application on October 21, 1999. Therefore, Jones has no relevance to this case.

Applicant : Herbert Howell Waddell
U.S. Serial No. : 09/693,239
Filing Date : October 20, 2000
Page : 3

B. Next, the Examiner Stated that:

"The Davis patent, as well as many other pieces of cited art, show and teach that it is very well known and common to attach two similar earth working tools together in order to grasp material between the tools. Davis further shows and teaches to use a metal, moveable hinge type device between the tools to make such an attachment."

The Applicant respectfully asserts that the post hole digging device of Davis is only functional when the two shovels are engaged in a rigid metal coupling that prevents rotation or other motion except in the desired scissors fashion in opposition to each other. The "metal, moveable hinge type device" can be moved, but not to another functional position. The device has no useful function if one shovel is moved along the shaft of the other and rotated. Therefore, Davis, with its rigid coupling that only works in one configuration, teaches away from use of a flexible coupling that is functional when moved from place to place along the shafts of the two grasping devices, and which permits the device to serve useful functions when the grasping elements are rotated around their axes.

C. Next, the Examiner states:

"The Decker reference's sole use was to display that it is very obvious to make such a hinge from an elastomer material such as rubber."

Decker '645 discloses that two handles can be attached to a snow shovel with a hinge in such a way that a "swing shovel" is formed that requires less stooping and lifting by the operator. The end of one handle is connected by a hinge of

Applicant : Herbert Howell Waddell
U.S. Serial No. : 09/693,239
Filing Date : October 20, 2000
Page : 4

elastomeric material to the shaft of the other handle. Movement of the hinge along the shaft or rotation of the handles is undesirable, so the hinge is fixed (in the words of the inventor) to the handles with adhesives or other means. The hinge is designed to permit only minimal side to side relative motion of the two handles about the pivot point, that is, to act as a hinge and not as a completely flexible coupling. The flexible coupling is fixed in place, so cannot be moved along the shafts and the shafts can not be rotated along their axes.

If the apparatus of Davis '359 is provided with the teachings of Decker '645, one would have a post hole digger with a fixed, flexible coupling just above the shovel heads. The coupling could not be moved to other functional positions along the shafts of the two grasping devices. Both Davis and Decker rely on methods of fixing the components in a single functional configuration, and do not teach nor suggest that it would be desirable to use a moveable flexible coupling to extend the functional range of a grasping device. Therefore, Davis and Decker taken together do not teach or suggest all limitations in independent claim 1 b) of the Applicant's invention, namely:

b) a flexible coupling means which can be moved along the shafts of the grasping elements to connect them together while permitting each of them to rotate along the axes of their shafts and to pivot with respect to each other so that the grasping heads can be brought together or moved apart from each other.

Applicant : Herbert Howell Waddell
U.S. Serial No. : 09/693,239
Filing Date : October 20, 2000
Page : 5

This claim emphasizes that the entire apparatus, grasping elements and coupling together, has a useful function wherever the coupling is placed along the shafts. This is also expressed in the specification, where it states:

"The coupling can be placed anywhere along the shafts at the convenience of the user to facilitate drawing together of the grasping means."

Section 2143.03 of the Manual of Patent Examining Procedure (1995) states:

"To establish prima facia obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 USC 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5USPQ2d 1596 (Fed. Cir. 1988).

Davis and Decker taken together do not meet the standard of In re Royka that "all the claim limitations must be taught or suggested by the prior art".

D. Next, the Examiner states:

"The attorney states that the Davis reference is more than 180 [sic] years old and should bear on obvious modification. The point is well taken by the Examiner

Applicant : Herbert Howell Waddell
U.S. Serial No. : 09/693,239
Filing Date : October 20, 2000
Page : 6

who strongly believes that if such a device was manufactured today, it would be of the elastomer material as taught by Decker if for no other reasons than cost and ease of manufacture."

The point that should be taken from a nearly one hundred eighteen year old patent is that if the new idea is really obvious from an old patent, someone should have discovered it before now, as stated in cited cases in our January 31, 2003 reply to the January 9, 2003 office action and in our appeal brief filed timely on October 15, 2002. Furthermore, post hole digger devices are still manufactured today with Fixed, rigid metal hinge couplings, and the Applicant is not aware of any commercial post hole diggers that are made with elastomeric couplings, whether fixed or moveable. Therefore, regarding the use of elastomeric couplings for opposed grasping devices, the Applicant respectfully traverses and submits that post hole diggers with elastomeric couplings are not known in the art.

The very long time that the devices to gather, pick up and carry loose materials have been known and improved by scores of inventions argues that no one has thought of the Applicant's invention in all that time and that it was not obvious to those skilled in the art. The Supreme Court has long established the principle that such secondary considerations as "long felt but unsolved needs [and] failure of others" may be relevant as indicia of obviousness or nonobviousness. Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966). "Thus evidence rising out of the so-called 'secondary considerations' must always when present be considered en

Applicant : Herbert Howell Waddell
U.S. Serial No. : 09/693,239
Filing Date : October 20, 2000
Page : 7

route to a determination of obviousness." Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1538, 218 USPQ 871, 876 (Fed. Cir. 1983) (quoting In re Sernaker, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983)). Evidence of secondary considerations may often be the most probative and cogent evidence in the record and all pieces of evidence should be fully considered and each should be given appropriate weight. Id. 1538-1539. Therefore, Applicant respectfully submits that the Examiner consider that no one has thought of the claimed invention despite the fact that the devices to gather, pick up and carry loose materials have long been known and improved by scores of inventions.

E. The Examiner then cited additional patents "for the applicant's examination". Since these references, which appeared for the first time in a final rejection action, were not included in the rejection statement as required for consideration, their relevance in the office action is not clear to the Applicant.

Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively stated in the rejection. See In re Hoch, 57 CCPA 1292, 428 F.2nd 1341, 166 USPQ 406, footnote 3 (1970)

All three references pertain to clips with open jaws on each end for holding cylindrical objects together in a static relationship. In Kramer '332 and Schioda, et al '961 the clips are manufactured from plastic materials. In Shioda '725, a design patent, the material is not mentioned. Kramer '332 claims a resilient web that acts like a fulcrum between

Applicant : Herbert Howell Waddell
U.S. Serial No. : 09/693,239
Filing Date : October 20, 2000
Page : 8

the opposing sets of jaws to allow them to operate somewhat like a pair of pliers, i.e. if you squeeze one set of jaws together, the other set opens. In Shiota, Two single-ended clips are joined to make a double-ended clip similar to that in Kramer. In the Shiota patents there is no need for resilience except in the jaws so that the clip can be attached to objects. In both Kramer and Shiota there is no intent to provide the degree of flexibility required by the coupling of the Applicant's invention, nor to provide the strength to resist the large dynamic forces that the coupling in the Applicant's device must withstand.

Obviously, the material used in the clips must be quite stiff or the jaws would not hold the items to be clipped together. As a result, clips would lack the flexibility required in the claimed grasping device. Furthermore, if a clip from Kramer or Shiota was substituted for the coupling used in the Applicant's invention, the shafts of the grasping devices would slip out the open jaws of the clip when force was applied, such as when grasping leaves with a pair of coupled rakes. Therefore, one looking for ways to improve grasping devices would not consider the teachings of Kramer and Shiota. In such case, when the Examiner relies on inventions other than that claimed in a patent application in showing that "some objective teaching" in the prior art would have suggested the claimed subject matter to a person of ordinary skill in the art, the Examiner is required to designate the particular part relied on as nearly as practical. 37 C.F.R. § 1.104(c) (2) provides in pertinent parts:

In rejecting claims for . . . obviousness, the Examiner must cite the best references at his or her

Applicant : Herbert Howell Waddell
U.S. Serial No. : 09/693,239
Filing Date : October 20, 2000
Page : 9

command. When a reference . . . shows or describes inventions other than that claimed by the Applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.
(emphasis added)

CONCLUSION

For the above reasons, Applicant respectfully requests that the above remarks be entered and made of record in the present application. An allowance is earnestly requested.

If a telephone interview would be of assistance in advancing prosecution of the subject application, Applicant's undersigned attorney invites the Examiner to telephone at the number provided below.

Respectfully submitted,

Albert Wai-Kit Chan

Albert Wai-Kit Chan
Registration No. 36,479
Attorney for Applicant
Law Offices of
Albert Wai-Kit Chan, LLC
World Plaza, Suite 604
141-07 20th Avenue
Whitestone, New York 11357
Tel: (718) 357-8836
Fax: (718) 357-8615
e-mail: kitchanlaw@aol.com